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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,125	10/25/2000	James M. Welch	7000-032	3540

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EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2643

3

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/696,125

Applicant(s)

WELCH ET AL.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-46 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Moss et al. (U.S Pat. #: 6,449,351).

Regarding claim 1, Moss et al. ("Moss") teaches a method of providing custom calling party identification information, the method comprising:

determining that customized CID information is desired for a call originating from an origination end-point (col.3, lines 8-22); and

providing the customized CID information in association with the call (col.3, lines 35-41);

wherein a device receiving the call can receive the customized CID information (col.3, lines 20-22).

Regarding claim 2, note col.3, lines 15-20.

Regarding claim 3, note col.3, lines 20-22 and col.3, lines 53-58.

Regarding claims 4-5, note col.3, lines 2-7 and col.3, lines 41-44.

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Regarding claim 6, note col.4, lines 35-54.

Regarding claims 7-12, note col.2, line 42 – col.3, line 7.

Regarding claims 13-17, note col.4, lines 35-67.

Regarding claim 18-25, note col.3, lines 2-7 and col.3, lines 41-44.

Regarding claim 26, the limitations of the claim are rejected with the same reasons set forth in claim 1 above.

Regarding claim 27, note col.3, lines 8-20.

Regarding claims 28-30, note col.3, line 31 – col.4, line 11.

Regarding claims 31-32 and 36-37, note col.4, lines 35-67.

Regarding claims 33-35, note col.3, lines 2-7 and col.3, lines 41-44.

Regarding claim 38, Moss teaches an apparatus facilitating provision of custom calling party identification (CID) comprising:

a means for selectively interconnecting a plurality of origination end-points in support of telecommunications functions based on dialable number information entered via individual ones of the plurality of origination end-points (see figure 2, note col.3, lines 2-7 and col.3, lines 41-44);

a means for determining that customized CID information is desired for a call originating from a given one of the plurality of origination end-points (col.3, lines 8-20);

a means for determining at least one custom value for use as at least a part of the customized CID information (col.3, line 23 – col.4, line 11);

a means for transmitting the custom CID information in association with the call (col.4, lines 11-35).

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Regarding claim 39, note col.3, lines 15-20.

Regarding claims 40-46, note col.4, lines 11-67.

Regarding claim 56, Moss teaches a method of providing custom calling party identification (CID) information, the method comprising:

determining that customized CID information is desired for a call originating from an originating end-point (col.3, lines 8-22);

comparing the customized caller ID information with inappropriate CID information (col.3, lines 28-30); and

providing the customized CID information in association with the call if the customized CID information does not match the inappropriate CID information (col.3, lines 35-41);

wherein a device receiving the call can receive the customized CID information (col.3, lines 20-22).

3. Claims 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Strauss et al. (U.S. Pat. #: 5,864,612).

Regarding claim 47, Strauss et al. ("Strauss") teaches a telecommunications local exchange switch such as SSP type central office shown in figure 2 comprising a first interface, a second interface (i.e., Interface Modules 51), a switching system (i.e., Communication Module 53) and a controller (i.e., Administrative Module 55). Strauss further teaches the controller adapted to selectively provide customized CID information in association with calls originating from at least one of the plurality of origination end-points based on the program instructions and operating data (i.e., if a call is dialed without access code, the call is processed and routed in

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conventional manner; col.7, line 60 – col.8, line 3; otherwise, the SSP queries and follows instructions to transmit custom CID to destination for completing the call; col.8, lines 35-50 and col.9, lines 3-20).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strauss et al. (U.S. Pat. #: 5,864,612) in view of Moss et al. (U.S. Pat. #: 6,449,351).

Regarding claim 48, Strauss teaches all subject matter as claimed above, except for the feature of providing the customized CID information based on determining whether a number dialed in association with a call originating from the at least one origination end-point matches

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one in a predefined list of stored number. However, Moss teaches such feature in col.3, line 8-44 for a purpose for presenting appropriate caller identification information to desired called party.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of the feature of providing the customized CID information based on determining whether a number dialed in association with a call originating from the at least one origination end-point matches one in a predefined list of stored number, as taught by Moss, into view of Strauss in order to improve of delivery of appropriate caller identification information to desired called party.

Regarding claims 49-55, Moss further teaches limitations of the claim in col.4, line 12-67.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents each also teach a method and a system for presenting customized caller ID to called party.

Snyder et al. (U.S. Pat. #: 5,784,444), Glass (U.S. Pat. #: 6,662,006) and Rhodes (U.S. Pat. #: 6,343,120).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

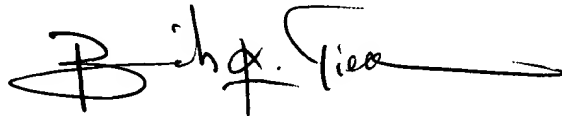
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

A handwritten signature in black ink, appearing to read "Binh K. Tieu", with a long horizontal flourish extending to the right.

**BINH TIEU**  
**PRIMARY EXAMINER**  
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Date: February 07, 2004